REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed April 7, 2005. In the Office Action, the Examiner notes that claims 1-63 and 79-81 are pending and rejected. By this response, the Applicant has amended claims 1, 22 and 43 and cancelled claims 79-81. The amendments to the claims are fully supported by the Specification. For example, the amendments are supported at least by page 70, lines 7-9, and by page 72, line 6, to page 74, line 3. Thus, no new matter has been added and the Examiner is respectfully requested to enter the amendments.

In view of both the amendments presented above and the following discussion, the Applicant submits that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, the Applicant believes that all of these claims are now in allowable form.

The Applicant, by amending the claims, does not acquiesce to the Examiner's characterizations of the art of record or to the Applicant's subject matter recited in the pending claims. Further, the Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response including amendments.

REJECTIONS

35 U.S.C. §103

Claims 1-5, 8, 9, 12-14, 16, 19-26, 29, 30, 33-35, 37, 40-47, 50, 51, 54-56, 58, 61-63 and 79-81

The Examiner has rejected claims 1-5, 8, 9, 12-14, 16, 19-26, 29, 30, 33-35, 37, 40-47, 50, 51, 54-56, 58, 61-63 and 79-81 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,553,178-B2 to Abecassis (hereinafter "Abecassis") in view of U.S. Patent 6,510,209 to Cannon (hereinafter "Cannon"). The Applicant respectfully traverses the rejection.

Applicant's independent claim 1 recites (emphasis added below):

> "1. A method for automatically pausing a video program in response to an occurrence of an event, comprising:

receiving a video program and outputting the video program for presentation on a display device;

detecting occurrence of an incoming request for communications during the video program;

pausing the outputting of the video program in response to the detection of the occurrence of the incoming request for communications;

buffering the video program in response to the detection of the occurrence of the incoming request for communications; and

outputting a signal for displaying an indication of the occurrence of the incoming request for communications."

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Abecassis and Cannon references alone or in combination fail to teach or suggest the Applicant's invention as a whole.

Specifically, the Abecassis and Cannon references, alone or in combination, fail to teach or suggest at least the "buffering the video program in response to the detection of the occurrence of the incoming request for communications" as recited in claim 1 as amended.

The Abecassis reference discloses an advertisement subsidized video on demand system in which, in relevant part, the user of the system may accept a communication during the use of the system and, in response to the acceptance of such communication, cause a video server transmission to be paused. However, as the Examiner acknowledges, "Abecassis fails to disclose detecting an occurrence of an incoming request and pausing the video program in response to the incoming request" (page 3 of the Office Action mailed on 4/7/05). Moreover, the Applicant respectfully submits that Abecassis also does not teach buffering the video program in response to the detection of the occurrence of the incoming request for communications. The Abecassis reference discloses (emphasis added below):

"RAViT further comprises computing elements and video processing elements readily found in multimedia devices and video

> electronic systems such as, for example and not limited thereto: i) microprocessor 511; ii) memory units 512; iii) video processor 513; and iv) video buffers 514." (column 20, lines 35-39)

The Abecassis reference thus discloses a video buffer, but does not disclose that the video server transmission is buffered in response to a request for communications. Instead, the Abecassis reference discloses (emphasis added below):

> "Where the video is being retrieved from a video services provider video server 1321, RAViT transmits to the video server the appropriate pause commands 1322, causing the video server to hold the further transmission of the video 1324. When the video is being retrieved from RAViT's own video storage module, (e.g. a Video CD) RAViT pauses the retrieval 1323 of the video from the storage module, also pausing the video transmission 1324." (column 52, lines 34-42)

Thus, to pause the display of the video, the Abecassis reference either transmits a command to a video server to pause the transmission of the video, or pauses retrieval of a video from a local storage module. By contrast, the present invention buffers the received video in response to the detection of the request for communication.

The Cannon reference fails to bridge the substantial gap between the Abecassis reference and the Applicant's invention. The Cannon reference discloses a telephone enabling remote programming of a video recording device. Specifically, the section of the Cannon reference cited by the Examiner discloses (emphasis added below):

> "The co-pending application describes a cordless telephone having a base unit and a handset, wherein at least one of the base unit and the handset is adapted to control a remotely controllable device, such as a television, a stereo, or a video cassette recorder (VCR). For example, when an incoming call is received, the co-pending application describes the transmission of a signal from either the base unit or the handset to a television via an infrared link, an RF link, or a wired connection, such as a connection via a 60 Hz power grid. The signal can control the television to mute upon receipt of the incoming call, to display caller ID data, to display parallel set status, etc.
>
> Instead of, or in addition to, controlling the television in response to an incoming call, the co-pending application also describes controlling a video recording device, such as a VCR, as well as the control of other audio-visual equipment. For example, if a VCR or videodisk player is in the process of playing a movie at the time the incoming call is received, the VCR or videodisk player can be paused or stopped in concert with the muting of the television and/or the display of the caller ID data on the television screen. This enables a television viewer to accept the incoming

> call without missing a portion of the movie, and without requiring the viewer to rewind and/or search for the point of interruption after completing the telephone conversation." (column 2, lines 41-65)

Thus, the Cannon reference discloses that a VCR or videodisk player can be paused upon receipt of an incoming call. However, the Cannon reference does not teach or suggest at least the "buffering the video program in response to the detection of the occurrence of the incoming request for communications" as recited in claim 1 as amended.

Thus, the Abecassis and Cannon references, either singly or in any optimal combination, fail to disclose or suggest the Applicant's invention as a whole.

Moreover, for prior art reference to be combined to render obvious a subsequent invention under 35 U.S.C. § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.SQ.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. In re Fine, 5 U.S.P.SQ.2d 1596, 1599 (Fed. Cir. 1988). Hindsight is strictly forbidden. It is impermissible to use the claims as a framework to pick and choose among individual references to recreate the claimed invention Id. at 1600; W.L. Gore Associates, Inc., v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

By alleging that the Applicants' inventon is taught by a combination of the Abecassis and Cannon references, the Examiner is using hindsight to pick and choose elements from the references to support his rejection. There is no motivation for combining the Abecassis and Cannon references in a manner that obviates the claimed invention. The Examiner alleges (emphasis added below):

> "Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Abecassis to detect the occurrence of an incoming request and automatically pause the video as taught by Cannon, thus enabling a user to accept the incoming call without missing a portion of the movie." (page 4 of the Office Action mailed on 4/7/05)

However, the Applicant respectfully disagrees. One of ordinary skill in the art would not be motivated to combine the Abecassis and Cannon references for the reason as alleged by the Examiner.

The Abecassis reference is directed to a "pointcast video delivery system" (Abstract) in which a Random Access Video Technologies device (RAVIT) "permits the viewer to retrieve content-on-demand videos and other services from media locally accessible or within the RAVIT, or from a remote video services provider" (column 18, lines 35-37). The Abecassis reference discloses (emphasis added below):

> "At the outset, it is emphasized that, in certain embodiments, a RAViT may be made available to a viewer that is as simple as a cable converter box capable of retrieving video-on-demand services from a remote video services provider. The RAViT configuration detailed below with respect to FIG. 5 integrates the capabilities of a "cable converter box" and a multimedia personal computer with B-ISDN communications capabilities. It is also noted that a preferred configuration of RAViT comprises all the elements of the nonlinear editing system previously detailed, with the additional advantage of a superior communications interface. As is suggested by, for example, the patent to Lang, U.S. Pat. No. 5,057,932, incorporated by reference herein, a variety a RAViT configurations are possible."

Thus, the Abecassis reference discloses that the RAVIT device may be as simple as a cable converter box capable of retrieving video-on-demand services, but which in a preferred configuration comprises all the elements of a non-linear editing system. Furthermore, the Abecassis reference discloses that in one embodiment, the RAVIT integrates the capabilities of a cable converter box with a personal computer.

By contrast, the Cannon reference discloses (emphasis added below):

> "The co-pending application describes a cordless telephone having a base unit and a handset, wherein at least one of the base unit and the handset is adapted to control a remotely controllable device, such as a television, a stereo, or a video cassette recorder (VCR). For example, when an incoming call is received, the co-pending application describes the transmission of a signal from either the base unit or the handset to a television via an infrared link, an RF link, or a wired connection, such as a connection via a 60 Hz power grid. The signal can control the television to mute upon receipt of the incoming call, to display caller ID data, to display parallel set status, etc."

Thus, the Cannon reference discloses a cordless telephone which is adapted to control a VCR. However, the cordless telephone discussed in the Cannon reference is not the same as the Random Access Video Technologies (RAVIT) device discussed in the Abecassis reference. One of ordinary skill in the art would not be motivated to combine

the apparatus and methods of a cable converter box having all the elements of a non-linear editing system with those of a cordless telephone due to the differences of these devices, including considerable differences of function and structure.

As such, the Applicant submits that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 22 and 43 contain substantially similar relevant limitations as those discussed above in regards to claim 1. Therefore, independent claims 22 and 43 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, the dependent claims including claims 2-5, 8, 9, 12-14, 16, 19-21, 23-26, 29, 30, 33-35, 37, 40-42, 44-47, 50, 51, 54-56, 58, and 61-63 depend, either directly or indirectly, from independent claims 1, 22, and 43 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, Applicant submits that these dependent claims are also non-obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Additionally, Claims 79-81 have been cancelled. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

Claims 6, 7, 27, 28, 48 and 49

The Examiner has rejected claims 6, 7, 27, 28, 48 and 49 as being unpatentable over Abecassis in view of Cannon in view of the MSN Messenger Service (hereinafter "MSN"). The Applicant respectfully traverses the rejection.

As discussed above, Abecassis and Cannon do not teach or suggest at least the "buffering the video program in response to the detection of the occurrence of the incoming request for communications" as recited in claim 1 as amended.

The MSN reference fails to bridge the substantial gap between the Abecassis and Cannon references and the Applicant's invention. The MSN reference discloses that a user can "[b]e automatically notified when you receive new messages in your Hotmail e-mail account" by the MSN Messenger Service. However, the MSN reference also does not teach or suggest at least the "buffering the video program in response to the detection of the occurrence of the incoming request for communications".

Thus, the Abecassis, Cannon and the MSN references, either singly or in any optimal combination, fail to disclose or suggest the present invention as a whole.

As such, the Applicant submits that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 22 and 43 contain substantially similar relevant limitations as those discussed above in regards to claim 1. Therefore, independent claims 22 and 43 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 6, 7, 27, 28, 48 and 49 depend, either directly or indirectly, from independent claims 1, 22 and 43 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicant submits that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

Claims 10-11, 31, 32, 52 and 53

The Examiner has rejected claims 10-11, 31, 32, 52 and 53 as being unpatentable over Abecassis in view of Cannon in further view of U.S. Patent 6,349,410 to Lortz (hereinafter "Lortz"). The Applicant respectfully traverses the rejection.

As discussed above, the Abecassis and Cannon references, alone or in combination, fail to teach or suggest at least the "buffering the video program in response to the detection of the occurrence of the incoming request for communications" as recited in claim 1 as amended.

The Lortz reference does not bridge the substantial gap between the Abecassis and Cannon references and the Applicant's invention. The Lortz reference discloses "[c]oordination of the display of an incoming signal stream (such as broadcast TV content or streaming web content) on a display with web browsing" (Abstract). The Lortz reference discloses (emphasis added below):

> "At block 40, the set top device stores the most recent URL associated with an incoming signal stream. The user at this point may be watching either the broadcast TV signal stream or the streaming audio and video web content on the display. When the user wants to access web content referenced by the most recent URL, the user in one embodiment presses the forward button 26 on

> the remote control. At block 42, the set top device receives the forward signal from the remote control. This causes the set top device to pause the display of the signal stream currently being received at block 44, while continuing to save the incoming signal stream on the storage device. The set top device then obtains the web content for the most recently stored URL from the appropriate web server at block 46. During the web page loading time, the display either shows the partial web page being built or it continues to show a "freeze-frame" of the incoming signal stream (either TV broadcast or Internet streaming audio and video) at the time of the pause." (column 3, lines 48-65)

Thus, the set top device saves the incoming signal stream on a storage device in response to the forward signal from the remote control. By contrast, the present invention buffers the video program in response to the detection of the incoming request for communication.

Thus, the Abecassis, Cannon and Lortz references, either singly or in any optimal combination, fail to disclose or suggest the present invention as a whole.

As such, the Applicant submits that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 22 and 43 contain substantially similar relevant limitations as those discussed above in regards to claim 1. Therefore, independent claims 22 and 43 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 10-11, 31, 32, 52 and 53 depend, either directly or indirectly, from independent claims 1, 22 and 43 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicant submits that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

Claims 15, 36 and 57

The Examiner has rejected claims 15, 36 and 57 as being unpatentable over Abecassis in view of Cannon in further view of U.S. Patent 6,543,053 to Li (hereinafter "Li"). The Applicant respectfully traverses the rejection.

As discussed above, the Abecassis and Cannon references, alone or in combination, fail to teach or suggest at least the "buffering the video program in response to the detection of the occurrence of the incoming request for communications" as recited in claim 1 as amended.

The Li reference does not bridge the substantial gap between the Abecassis and Cannon references and the Applicant's invention. The Li reference discloses a data distribution system with video-on-demand services including VCR-like functions such as a pause function. However, the Li reference also does not teach or suggest at least the "buffering the video program in response to the detection of the occurrence of the incoming request for communications".

Thus, the Abecassis reference and the Li reference, either singly or in combination, fail to teach or suggest the present invention as a whole.

As such, the Applicant submits that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 22 and 43 contain substantially similar relevant limitations as those discussed above in regards to claim 1. Therefore, independent claims 22 and 43 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 15, 36 and 57 depend, either directly or indirectly, from independent claims 1, 22 and 43 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicant submits that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

Claims 17, 38 and 59

The Examiner has rejected claims 17, 38 and 59 as being unpatentable over Abecassis in view of Cannon in further view of U.S. Patent 6,052,508 to Mincy (hereinafter "Mincy"). The Applicant respectfully traverses the rejection.

As discussed above, the Abecassis and Cannon references, alone or in combination, do not teach or suggest at least the "buffering the video program in

response to the detection of the occurrence of the incoming request for communications" as recited in claim 1 as amended.

The Mincy reference does not bridge the substantial gap between the Abecassis and Cannon references and the Applicant's invention. The Mincy reference discloses editing interfaces for a moving picture recording device, the interfaces including "[t]he 'FRAME' keys, denoted as '<' and '>', [which] step a display frame back or ahead by one" (column 19, lines 47-48). However, the Mincy reference also does not teach or suggest at least the "buffering the video program in response to the detection of the occurrence of the incoming request for communications".

Thus, the Abecassis, Cannon and the Mincy reference, either singly or in combination, fail to teach or suggest the Applicant's invention as a whole.

As such, the Applicant submits that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 22 and 43 contain substantially similar relevant limitations as those discussed above in regards to claim 1. Therefore, independent claims 22 and 43 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 17, 38 and 59 depend, either directly or indirectly, from independent claims 1, 22 and 43 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicant submits that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

Claims 18, 39 and 60

The Examiner has rejected claims 18, 39 and 60 as being unpatentable over Abecassis in view of Cannon in further view of the ReplayTV manual (hereinafter "ReplayTV"). The Applicant respectfully traverses the rejection.

As discussed above, the Abecassis and Cannon references, alone or in combination, do not teach or suggest at least the "buffering the video program in response to the detection of the occurrence of the incoming request for communications" as recited in claim 1 as amended.

The ReplayTV reference does not bridge the substantial gap between the Abecassis and Cannon references and the Applicant's invention. The ReplayTV reference discloses a 'Return to Live' button which "[r]eturns your ReplayTV to live television broadcasts after using PAUSE, REWIND, FAST FORWARD, or STOP" buttons. However, the ReplayTV reference also does not teach or suggest at least the "buffering the video program in response to the detection of the occurrence of the incoming request for communications".

Thus, the Abecassis, Cannon and ReplayTV references, either singly or in combination, fail to teach or suggest the Applicants invention as a whole.

As such, the Applicant submits that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 22 and 43 contain substantially similar relevant limitations as those discussed above in regards to claim 1. Therefore, independent claims 22 and 43 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 18, 39 and 60 depend, either directly or indirectly, from independent claims 1, 22 and 43 and recite additional limitations thereof. As such and at least for the same reasons as discussed above, the Applicant submits that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

CONCLUSION

Thus, Applicant submits that none of the claims presently in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Stephen Guzzi at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 7/6/05

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